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Serial No. 09/688,501

Incoming _____ Date Received: _____

Outgoing ✓ Date Mailed: 08/07/07

TOC Code: APDP

Document Name: Board Decision

Annotations: Affirmed-in-part

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHRIDHAR P. JOSHI

Appeal 2007-1924
Application 09/688,501¹
Technology Center 3700

Decided: August 8, 2007

Before JENNIFER D. BAHR, LINDA E. HORNER, and DAVID B. WALKER,
Administrative Patent Judges.

WALKER, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ The real party in interest is WMS Gaming, Inc. of Chicago, Illinois.

STATEMENT OF THE CASE

Shridhar P. Joshi (“Appellant”) seeks our review under 35 U.S.C. § 134 of the Examiner’s final rejection of claims 37-62. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.²

THE INVENTION

Appellant claims:

A remote gaming method comprising a player accessing, via a remote terminal, a gaming site on a global computer network connected to the remote terminal. The player is able to provide via the remote terminal, personal identification information to the gaming site and select, via the remote terminal, a game of chance located at a gaming establishment for remote play. The remote terminal is located outside the gaming establishment. The player places, via the remote terminal, a wager for playing the selected game and receives randomly generated text or graphical outcome data at the remote terminal for the selected game. The outcome data being generated by either a gaming server or a gaming machine at the gaming establishment and is subsequently relayed to the gaming site.

(Specification 3:5-14).

Claims 37 and 39, reproduced below, are representative of the subject matter on appeal.

37. A remote gaming method comprising:

² Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

accessing, via a remote terminal, a gaming site on a global computer network connected to said remote terminal;

providing, via said remote terminal, personal identification information to said gaming site;

selecting, via said remote terminal, a game of chance from a plurality of gaming machines located at a gaming establishment for remote play, said remote terminal being located outside said gaming establishment;

placing, via said remote terminal, a wager for playing said selected game; and

receiving randomly-generated text or graphical outcome data at said remote terminal for said selected game, said outcome data being generated by one of said plurality of gaming machines at said gaming establishment and relayed to said gaming site through a gaming server connected to said gaming site.

39. A method for playing a gaming machine located inside a gaming establishment from a remote terminal located outside the gaming establishment comprising:

establishing a communication link between said remote terminal and a gaming site on a global computer network, said gaming site in communication with a gaming server for collecting outcome data from gaming machines located inside the gaming establishment;

selecting a gaming machine at said gaming establishment using said remote terminal;

making a wager to play the selected gaming machine;

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receiving outcome data, including game outcome,
at said remote terminal resulting from a play of said
gaming machine; and

generating a payout if said game outcome meets
predetermined criteria.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the
rejections:

Walker	US 6,001,016	Dec. 14, 1999
Wiltshire	US 6,409,602 B1	Jun. 25, 2002
Paravia	US 6,508,710 B1	Jan. 21, 2003

The following rejections are before us for review.

1. Claims 37-38 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wiltshire in view of Paravia.
2. Claims 39-62 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wiltshire in view of Walker.

ISSUES

The issues before us are whether Appellant has shown that the Examiner erred in rejecting the following claims under 35 U.S.C. § 103(a): (1) claims 37-38 as unpatentable over Wiltshire in view of Paravia; and (2) claims 39-62 as unpatentable over Wiltshire in view of Walker. The first issue turns on whether Wiltshire or Paravia discloses selecting a game of chance from a plurality of

gaming machines located within a gaming establishment and generating outcome data at one of a plurality of gaming machines located within the gaming establishment. The second rejection turns on whether Wiltshire or Walker discloses (1) selecting a gaming machine within a gaming establishment from a remote terminal located outside the gaming establishment; and (2) a gaming website that is in communications with a gaming server for collecting outcome data from gaming machines located inside a gaming establishment.

FINDINGS OF FACT

We find the following enumerated findings to be supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Wiltshire teaches a computer gaming system and method of operation wherein the gaming programs are executed entirely on a server/host computer, with only wagering input and display output operations being executed on the client/terminal computers to reduce the cost of hardware and software required for each client/terminal computer (Wiltshire, col. 2, ll. 22-51).
2. Wiltshire does not disclose selecting, via a remote terminal, a game of chance from a plurality of gaming machines located at a gaming establishment for remote play (Wiltshire, *passim*).

3. Wiltshire also does not teach randomly generating outcome data at one of a plurality of gaming machines located within a gaming establishment (Wiltshire, *passim*).
4. Wiltshire further discloses a computer gaming system wherein a gaming server/host computer is connected to a plurality of remote client/terminal computers via network interface and communications pathways (Wiltshire, col. 3, ll. 61-66). Wiltshire teaches that the communications pathways can be any type of local area, wide area or global communication pathways, including the Internet and the World Wide Web (Wiltshire, col. 5, ll. 30-32). Wiltshire teaches that the client terminal first connects to a website to download the terminal software, installs the software on the client/terminal, and then uses the software to connect to the server/host computer (Wiltshire, col. 8, ll. 15-33).
5. Wiltshire does not teach that the website for downloading the client/terminal software is in communication with a gaming server for collecting outcome data from gaming machines located inside a gaming establishment (Wiltshire, *passim*).
6. Paravia teaches an automated gaming service for one or more players that can be implemented in a computer-based environment to allow automated computation of wagers, payouts, and other parameters (Paravia, col. 1, 60-67).

7. Paravia does not disclose selecting, via a remote terminal, a game of chance from a plurality of gaming machines located at a gaming establishment for remote play (Paravia, *passim*).
8. Paravia also does not teach randomly generating outcome data at one of a plurality of gaming machines located within a gaming establishment (Paravia, *passim*).
9. Walker teaches a method and system for remote play of a gaming device, such as a slot machine using a gaming server, a plurality of gaming devices, and a remote wagering terminal. The gaming devices are configured to generate outcome data and automatically communicate the outcome data to the gaming server, which is configured to select outcome data from at least one of the gaming devices for receipt by the remote wagering terminal (Walker, col. 2, ll. 51-59).
10. Walker teaches a remote wagering terminal that transmits the play preferences to a slot network server that stores the play preferences. Based on the play preferences, the slot network server identifies the outcome data from one or more slot machines and transmits this outcome data from those slot machines to the remote wagering terminal (Walker, col. 3, ll. 42-48).
11. Walker discloses an alternate embodiment wherein the remote wagering terminal does not make a payout but rather directs the slot network server to increment the credit balance by the amount of the payout (Walker, col. 7, ll. 60-64).

12. Walker does not teach a gaming website in communication with a gaming server for collecting outcome data from gaming machines located inside the gaming establishment (Walker, *passim*).
13. Claim 6 of Walker discloses “said step of receiving data includes receiving a slot machine type” (Walker, col. 13, ll. 11-12).
14. Claim 7 of Walker discloses “wherein said step of receiving data includes receiving player preferences” (Walker, col. 13, ll. 13-14).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial

burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444; *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

ANALYSIS

A. Rejection of claims 37-38 under 35 U.S.C. § 103(a) as unpatentable over Wiltshire in view of Paravia.

Contrary to the findings of the Examiner, Wiltshire discloses neither selecting a game of chance from a plurality of gaming machines located within a gaming establishment nor generating outcome data at one of a plurality of gaming machines located within a gaming establishment (Findings of Fact 2-3). The Examiner's reference to Figures 4B-9D of Wiltshire does not meet the missing limitations, because the displayed gaming machines are virtual machines and the gaming programs are executed entirely on a server/host computer (Finding of Fact 1). Paravia also fails to teach the missing limitations. The Examiner has provided no reference showing the missing limitations, nor has he made a prima facie case of obviousness of claims 37-38 over Wiltshire in view of Paravia.

B. Rejection of claims 39-62 under 35 U.S.C. § 103(a) as unpatentable over Wiltshire in view of Walker.

Appellant argues that the rejection of independent claims 39, 52, and 62 is improper because “Wiltshire and Walker fail to teach or suggest selecting a gaming machine within a gaming establishment from ‘a remote terminal located outside the gaming establishment.’” (Br. 16). Wiltshire teaches accessing a game server which runs gaming programs from a remote terminal, but does not disclose selecting a gaming machine within a gaming establishment from a remote terminal located outside the gaming establishment (Findings of Fact 1-2). Walker teaches entering play preferences at a remote wagering terminal that are used by a slot network server to select one or more slot machines (Finding of Fact 10).

Appellant argues that Walker appears to teach that “the remote wagering terminal is located right there on the premises of the gaming establishment.” (Br. 17) The Appellant relies in part on the fact that Walker discloses coin hoppers with each slot machine that would be difficult to service if the remote wagering terminals were not located in the gambling establishment (Br. 17). However, Walker also discloses an alternate embodiment wherein the remote wagering terminal does not make a payout but rather directs the slot network server to increment the credit balance by the amount of the payout (Finding of Fact 11). Walker does not explicitly limit the location of the remote wagering terminal to the gaming establishment, and its name at least implies the contrary. Moreover, Wiltshire teaches remote client/terminals that would meet the remote terminal limitation of claims 39, 52, and 62.

Appellant also argues that the rejection of claims 39, 52, and 62 is improper because “Wiltshire and Walker fail to teach or suggest ‘relaying outcome data’ through a gaming site” (Br. 17). Appellant is correct, but only as to claim 39, because the disputed limitation does not appear in the language of claims 52 or 62. Wiltshire discloses a website for downloading client/terminal software, but does not teach that the website is in communication with a gaming server for collecting outcome data from gaming machines located inside a gaming establishment as required by independent claim 39 (Findings of Fact 4-5). Walker does not correct that deficiency (Finding of Fact 12). The Examiner has provided no reference showing the missing limitation, nor has he made a *prima facie* case of obviousness over Wiltshire in view of Walker with respect to claim 39 and its dependent claims, 40-51.

Because the disputed claim limitation is not present in claims 52 and 62, Appellant has not shown that the Examiner erred in rejecting claims 52 and 62. Moreover, because Appellant separately argues only claims 56 and 57, claims 53-55 and 58-61 fall with claim 52. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

Appellant argues that “Walker fails to teach or suggest outcome data that includes a ‘gaming machine type,’ as required by claims 46 and 56.” (Br. 18). Appellant misstates the language of claim 56, which actually requires that “said operation of receiving information includes receiving a gaming machine type” (Br. Claim Appendix 6). In fact, claim 6 of Walker discloses “said step of receiving data includes receiving a slot machine type,” (Finding of Fact 13), which meets the

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limitation of claim 56 of “receiving a gaming machine type.” Appellant has not shown that the Examiner erred in rejecting claim 56.

Appellant further argues that “Walker fails to teach or suggest outcome data that includes ‘player preferences’ as required by claims 47 and 57.” (Br. 19). Appellant misstates the language of claim 57, which actually requires that “said operation of receiving information includes receiving player preferences” (Br. Claim Appendix 6). In fact, claim 7 of Walker discloses “wherein said step of receiving data includes receiving player preferences,” (Finding of Fact 14), which meets the disputed limitation of claim 57. Appellant has not shown that the Examiner erred in rejecting claim 57.

CONCLUSIONS

We conclude that Appellant has shown that the Examiner erred in rejecting claims 37-51 under 35 U.S.C. § 103(a), but has not shown that the Examiner erred in rejecting claims 52-62 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 37-51 under 35 U.S.C. § 103(a) is reversed. The decision of the Examiner to reject claims 52-62 under 35 U.S.C. § 103(a) is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED-IN-PART

JRG

NIXON PEABODY LLP
161 N CLARK ST.
48TH FLOOR
CHICAGO, IL 60601-3213